

REMARKS

This is a full and timely response to the final Office Action of February 12, 2001. Upon entry of this Third Response, claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 remain pending in this application. Reconsideration, and allowance of the application and all presently pending claims are respectfully requested.

Response to §103 Rejections

The “fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art.” *Applied Materials Inc. v. Gemini Research Corp.*, 15 U.S.P.Q.2d 1816, 1818 (Fed. Cir. 1988). “(A)n applicant’s own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application.” *In re DeBaun*, 214 U.S.P.Q. 933, 935 (C.C.P.A. 1982).

Therefore, an applicant may overcome a rejection based on a patent “by showing that the patent disclosure is a description of applicant’s own previous work. Such a showing can be made by proving that the patentee was associated with applicant (*e.g.* worked for the same company) and learned of applicant’s invention from applicant.” M.P.E.P. §2136.05; see also *In re Mathews*, 161 U.S.P.Q. 276 (C.C.P.A. 1969).

Similar issues dealing with whether subject matter disclosed within a prior patent to John Ross could be asserted against Applicant in a later filed application were addressed in U.S. Patent Application No. 09/233,795. In that case, the Patent Office withdrew the prior patent as a prior art reference, pursuant to *DeBaun*, *Mathews*, and M.P.E.P. §2136.05, on the grounds that John Ross

derived the relevant subject matter from the Applicant. The Examiner is invited to refer to the foregoing patent application as a prelude to the following arguments.

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand rejected under 35 U.S.C. §103 as purportedly being obvious to *Ross* in view of *Bolger*. However, for the reasons set forth in the First Response filed on July 31, 2000, Applicant asserts that the subject matter disclosed by *Ross* and used to reject the pending claims of the instant application was derived from Applicant. Thus, *Ross* is not a proper prior art reference, and the rejection to claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 should be withdrawn.

In rejecting the foregoing claims, it is asserted in the Office Action that:

Applicant, in citing Applied Materials Inc. v. Gemini Research Corp, In re DeBaun, MPEP 2136.05 and In re Mathews, argued that "the fact that an application has named a different inventive entity (than) a patent does not necessarily make that patent prior art." The key word is "necessarily". Although, applicant's statement is true, it is not so at all times and in all situations. (Footnotes omitted).

Applicant agrees that the term "necessarily" implies that a patent having a different inventive entity may, at times, be used as prior art against an application. More specifically, the patent may be used as a prior art reference in instances when an applicant fails to show that the subject matter of the patent has been derived from applicant's own work and/or when the patent has been published for more than one year prior to the filing date of an Applicant's application. However, when an applicant shows that the subject matter of the patent has been derived from his own work, then (in the absence of a time bar) the subject matter should not be used against the applicant to reject his application, pursuant to the law set forth by *DeBaun*, *Mathews*, and M.P.E.P. §2136.05.

It is further asserted in the Office Action that:

In reference to Applied Material Inc. v. Gemini Research, the examiner agrees. However, if the patent has an earlier US effective filing date than the application, such patent is considered to be prior art. In the present case, the present application (has a) filing date of May 6, 1997, while the prior art references have an effective US filing date of may 14, 1993.

The situation in In re DeBaun only applies to the same applicant for the patent and the application. By same applicant, it's meant the same inventive entity. In the present case, the present application names only Martin Kelly Jones, while the applied patents name only John Ross. (Footnotes admitted).

Applicant recognizes that the law set forth by the *Applied Material* and *DeBaun* cases may be applied in situations when a patent has an earlier U.S. filing date than an application and when a patent and an application have common inventorship. However, there is no requirement in the case law for an applicant to show that one of these conditions exists in order to remove a patent as a prior art reference pursuant to the foregoing cases.

Indeed, in the case of *In re Mathews*, Dewey filed a patent application for a time delay protective device for an electronic circuit. 161 U.S.P.Q. 276 (C.C.P.A. 1969). The patent application (which issued as U.S. Patent No. 3,105,920) included unclaimed subject matter derived from Mathews, who was a co-worker of Dewey. Later, Mathews filed a patent application pertaining to the unclaimed subject matter disclosed in the earlier filed Dewey patent. The Court found that the Dewey patent included a “full disclosure of the invention now claimed by Mathews.” *Id.* at 277. Because the subject matter derived by Mathews was not claimed in the Dewey patent, Mathews was not named as an inventor in the Dewey patent. However, the Court held that the Dewey patent could not be applied as a prior art reference against the Mathews application, “since Dewey derived his knowledge (of the relevant subject matter) from Mathews.” *Id.* at 278. Therefore, the Dewey patent was not considered to be a prior art reference to the Mathews patent application even though: (a) the Dewey patent was filed before the effective filing date of the

Mathews patent application, and (b) Mathews was *not* an inventor in the Dewey patent (*i.e.*, the Dewey patent and the Mathews patent application properly named different inventive entities). Accordingly, there is no requirement that an applicant must establish that he is a named inventor of a prior patent to remove the patent as a prior art reference via an affidavit/declaration under 37 C.F.R. §1.132.

In fact, M.P.E.P. §2136.05 states that “(w)hen a prior U.S. patent is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by antedating the filing date of the U.S. patent under 37 C.F.R. §1.131 or by submitting an affidavit or declaration under 37 C.F.R. §1.132 establishing that the relevant disclosure is applicant’s own work.” (Emphasis added). There is no requirement in M.P.E.P. §2136.05 for the applicant to be named as an inventor in the prior U.S. patent.

Furthermore, the Court of Customs and Patent Appeals has stated in the case of *In re Land* and *Rogers* that:

there are two conditions expressed in section 102(e): (1) the application for the reference patent must have been by one who is legally “another” and (2) the filing date must be “before the invention * * * by the applicant * * *.” When the 102(e) reference patentee got knowledge of the applicant’s invention from him, as by being associated with him, * * * and *thereafter* describes it, he necessarily files the application *after* the applicant’s invention date and the patent as a “reference” does not evidence that the invention, when made, was already known to others. (Footnote omitted.) Evidence of such a state of facts, whatever its form, must be considered. 151 U.S.P.Q. 621, 633 (1966); see, also, *Mathews* at 279.

Noting that there is no mention of a requirement in *Land* for an applicant to be named as an inventor in a prior patent to overcome the prior patent as a reference, Applicant submits that the arguments in the Office Action incorrectly focus on the “by another” requirement of 35 U.S.C. §102(e) instead of the “before the invention” requirement. In focusing on the “before the invention” requirement, the “proper subject of inquiry” is “*who* invented the subject matter disclosed by (the reference) which was relied on to support the rejection.” *Id.* at 633 n. 11; see,

also, *DeBaun* at 935. More specifically, if it can be shown that Ross derived the relevant subject matter from the Applicant, then Ross is not the inventor of the relevant subject matter, and the filing date of any *Ross* patent that includes the relevant subject matter is necessarily after the date that Applicant invented the relevant subject matter. Therefore, the proper inquiry is not who first disclosed the subject matter but rather who invented the subject matter. Consequently, to overcome a prior art reference under 35 U.S.C. §102(e), all that needs to be shown (in the absence of a time bar) is that the subject matter relied on by the Examiner to reject the applicant's patent application was derived from the applicant.

It is further alleged in the Office Action that:

As to In re Mathews, one major difference between the present application and the In re Mathews' case is that Dewey and Mathews were co-workers. In the present case there is no showing (other than applicant's statement) that applicant and Ross were co-workers. In fact, let it be known that the US patents to Ross, which named only one inventor, Mr. John Ross, are assigned to Worldwide Notification Systems, Inc. and the present application, which names only one inventor, Mr. Martin Kelly Jones, is assigned to Global Research systems, Inc.

Applicant respectfully traverses the assertion that the Applicant must show that he and Ross were co-workers to remove the *Ross* patents as prior art under 37 C.F.R. §1.132.

In this regard, to remove a prior art reference under 37 C.F.R. §1.132 in the absence of a time bar, it is only necessary to show that the named inventor of the prior patent derived his knowledge of the relevant subject matter from the applicant. The applicant and prior inventor being co-workers is only one scenario in which this may happen, and *Mathews* should not be interpreted as requiring evidence showing that the applicant was a co-worker of the named inventor of the prior patent. In fact, it is asserted in M.P.E.P. §2136.05 that:

when the unclaimed subject matter of a patent is applicant's own invention, applicant may overcome a *prima facie* case based on the patent by showing that the patent disclosure is a description of applicant's own previous work. Such a showing

can be made by proving that the patentee was associated with applicant (*e.g.* worked for the same company) and learned of applicant's invention from applicant. (Emphasis added).

Therefore, it is recognized by the M.P.E.P. that the applicant being a co-worker of the named inventor is only an *example* of a scenario in which the named inventor may be "associated" with an applicant so that the named inventor may derive subject matter from the applicant. Accordingly, Applicant respectfully asserts that there are other scenarios in which the named inventor may derive subject matter from the applicant, and it is not necessary for the Applicant to submit evidence showing that the Applicant and Ross were co-workers to remove the *Ross* patents as prior art references pursuant to *In re Mathews*.

In addition, even though Applicant traverses the foregoing "co-worker" requirement, Applicant submits that the "co-worker" requirement is satisfied by the facts of the present case. In this regard, Exhibits A - F submitted along with the First Response filed on July 31, 2000, show that Applicant and Ross were attempting to form a business together and that Ross was responsible for raising money for the business. Therefore, Applicant submits that he and Ross were, in fact, "co-workers."

It is further asserted in the Office Action that:

Applicant further argued that "there is no requirement in MPEP 2136.05 for the applicant to be named as an inventor in the prior US patent." While this may be true, the [MPEP] states that "The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art." *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 15 USPQ2d 1816 (Fed. Cir. 1988). However, the MPEP continues by stating "***[T]he issue turns on what the evidence of record shows as to who invented the subject matter.***" Furthermore, the MPEP states that "applicant may overcome a prima facie case based on the patent by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (*e.g. worked for the same company*) and learned of applicant's invention from applicant." In the case of *In re Land and Rogers* used by applicant, it is noted that *the inventors worked for the same*

company (Polaroid) and in the same laboratory. Even they worked for the same company, as the MPEP mentions, “The court affirmed the rejection because (1) the inventive entities of the patents (one to Rogers and one to Land) and (2) Land and Rogers brought their knowledge of their individual work with them when they made the joint invention. *There was no indication that the portions of the references relied on disclosed anything they did jointly. Neither was there any showing that what they did jointly was done before the filing of the reference parent applications.*”

For the following reasons, Applicant fails to see how the foregoing statements in the Office Action show that the rejections in the outstanding Office Action are proper.

First, Applicant agrees that the “issue turns on what the evidence of record shows as to who invented the subject matter.” In this regard, Applicant asserts that the evidence of record shows (1) that Applicant invented the subject matter disclosed by the *Ross* patent and used to reject the pending claims and (2) that *Ross* derived this subject matter from Applicant. Thus, as previously set forth hereinabove, *Ross* is not a valid prior art reference.

Second, Applicant admits that the rejection in *Land* was affirmed because there “was no indication that the portions of the references relied on disclosed anything they did jointly.” However, in *Land*, a joint application filed by Rogers and Land was being rejected by one or more patents naming Land as the only inventor and one or more patents naming Rogers as the only inventor. Further, as previously set forth herein numerous times, for *DeBaun*, *Mathews*, and M.P.E.P. §2136.05 to be applicable, the applicant of a later filed application must show that he invented the subject matter being used to reject his application and that the named inventor of the asserted prior art reference derived the subject matter from the applicant. Therefore, applying the foregoing rule to the situation in *Land*, Rogers and Land had to show that the subject matter being used to reject their later filed joint application was invented by them jointly. If this was true, then the relevant subject matter disclosed in the patents to Rogers individually and in the patents to Land

individually is considered to have been derived from the applicant (*i.e.*, both Rogers and Land) of the later filed joint application. As a result, the individual patents to Land and to Rogers could be removed as prior art references under *DeBaun, Mathews*, and M.P.E.P. §2136.05. However, since the Court found that the foregoing was not true (*i.e.*, since the Court found that Land and Rogers did not jointly invent the relevant subject matter), the Court held that the relevant subject matter was not derived from the applicant (*i.e.*, both Rogers and Land) but instead was derived from Rogers individually and from Lands individually. Therefore, the Court properly held that the rule of law set forth in *DeBaun, Mathews*, and M.P.E.P. §2136.05 should not be applied.

However, in the instant case, the Applicant is not a joint inventor, unlike the applicant in the *Lands* case. Thus, it is not necessary to show that the Applicant jointly invented the relevant subject matter disclosed in *Ross* in order to have *Ross* removed as a prior art reference pursuant to *DeBaun, Mathews*, and M.P.E.P. §2136.05. Indeed, applying the rule of law set forth by *Land* to the facts of the instant case, Applicant must show that he *individually* invented the subject matter being used to reject the pending claims and that *Ross* derived this subject matter from the Applicant. If this is true, then *Ross*, according to the law set forth in *Land* and M.P.E.P. §2136.05, must be removed as a prior art reference in the absence of a time bar. Hence, even though the Court decided not to remove the prior patents as prior art references in *Land*, there is nothing in the holding of the *Land* case to suggest that *DeBaun, Mathews*, and M.P.E.P. §2136.05 should not be applied in the instant situation.

It is additionally asserted in the Office Action that:

While MPEP 2136.05 does not mention that the application has to be named as an inventor in a prior US Patent to remove this reference as prior art by an affidavit/declaration, MPEP 715 only refers to “joint application or patent” or “commonly owned application or patent.”

Finally, as stated in MPEP 716, "It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection are responsible to the rejection and present sufficient facts to overcome the rejection.

Applicant submits that M.P.E.P. §§715 and 716 do not cover all situations and fact patterns upon which an applicant can remove a reference as prior art. Indeed, whether or not M.P.E.P. §§715 and 716 refer only to joint patents is not germane as to whether or not *Ross* can be removed as a prior art reference pursuant to rules set forth by *DeBaun, Mathews*, and M.P.E.P. §2136.05. Thus, Applicant fails to see how the foregoing assertions in the Office Action tends to support the Patent Office's position that *Ross* should not be removed as a prior art reference even though the evidence of record clearly shows that requirements set forth by *DeBaun, Mathews*, and M.P.E.P. §2136.05 have been satisfied in the instant case.

It is also asserted in the Office Action that:

On page 4 of the response, applicant contended that "there is no requirement that an applicant must establish that is a named inventor of a prior patent to remove the patent as prior art reference via an affidavit/declaration under 37 CFR 1.132." While this may be true, it must clear of record that the patent application and the prior art reference is commonly owned or assigned. Which is not the case in the present situation. Not only the present application and the prior art reference name different inventors and different inventive entities, they are not commonly owned or assigned....

Applicant can (file) an affidavit to overcome the rejection. However, this can only happen in the case where i) applicant is one of a group of inventors of the patent or ii) the application and the patent are assigned to the same assignee.

Applicant respectfully traverses the above conclusions and asserts that there is no basis in the case law for requiring the Applicant to show either of the foregoing contingencies. As set forth hereinabove, the law set forth in *Mathews* shows that an applicant does not have to be a named inventor of a patent to remove the patent as a prior art reference via a Declaration under 37 C.F.R. §1.132. Further, the verdict in *Mathews* does not appear to turn on whether or not the patent and

the application are assigned to the same entity. Indeed, as set forth hereinabove, the rationale behind removing a patent as a prior art reference when the patent includes subject matter derived from an applicant is directed toward the fact that the applicant, not the named inventor of the patent, is the inventor of the relevant subject matter. See *Land* at 633 and *Mathews* at 278 in which the Court in *Mathews* specifically held that the applicant was the “the original, first, and sole inventor.” Further, whether or not an application and a patent are assigned to the same entity is irrelevant in inventorship issues. Thus, whether or not Applicant and Ross have assigned their interest to the same entity should be irrelevant in determining whether or not Applicant’s declarations may be considered to overcome *Ross* pursuant to the foregoing case law. As a result, the requirement in the Office Action for the Applicant to show either (1) that he is a named inventor of the *Ross* patent or (2) that the present application and the *Ross* patent are assigned to the same entity does not comport with the case law set forth hereinabove.

It is further asserted in the Office Action that:

Applicant submitted a plurality of exhibits in support to show that the subject matter disclosed by Ross and used in the office action to reject the claims is the product of applicant’s own previous work. Applicant then asserts that the Ross patent is not prior art.

The mere fact that applicant has submitted several exhibits including a declaration filed by applicant stating that applicant is a “co-inventor” of the patents to Ross and that applicant invented the subject matter disclosed in the patents to Ross, is not a basis to remove Ross patents as prior art and withdrawn the rejections.

The examiner has considered and reviewed all the documents (exhibits) presented before him. However, based on the limited information presented herein, the examiner is not able to make a decision as to withdrawn the rejections. Applicant would need a disclaimer from Mr. Ross and/or the Assignee of the Ross patents affirming that applicant’s statement is true or any other evidence showing such.

Applicant respectfully asserts that there is nothing in the case law or the M.P.E.P. that requires an applicant to show an admission from the inventor or owner of a patent in order to overcome the

patent pursuant to *DeBaun, Mathews*, and M.P.E.P. §2136.05. Thus, Applicant asserts that the declarations and other evidence submitted by him are sufficient for showing that Ross derived from the Applicant the subject matter being used to reject the pending claims of the instant application. Therefore, the declarations and other evidence submitted by the Applicant are sufficient for overcoming *Ross* pursuant to *DeBaun, Mathews*, and M.P.E.P. §2136.05.

For the foregoing reasons, Applicant asserts that *Ross* is not a valid prior art reference to the instant application as alleged in the Office Action. Therefore, the rejection to pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 is improper and should be withdrawn.

Response to Double Patenting Rejections

Claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-30 of copending Application No. 09/395,497 and claims 1-36 of copending Application No. 09/163,958. Furthermore, claims 1-11, 13, 14, 16-23, 27-32, 35 and 36 presently stand provisionally rejected under the judicially created doctrine of double patenting over claims 1-21 and 23-49 of copending Application No. 08/852,119. Applicant respectfully traverses these provisional rejections and asserts that the claims of the foregoing applications do not suggest each feature of pending claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55. Noting that the foregoing rejections are provisional, Applicant requests that the rejections be withdrawn when the present application is otherwise in a condition for allowance pursuant to M.P.E.P. §823.

Furthermore, claims 1-11, 13, 14, 16-23, 27-32, 35-39, and 41-55 presently stand rejected under the judicially created doctrine of double patenting over claims 1-16 of U.S. Patent No. 5,623,260, claims 1-15 of U.S. Patent No. 5,657,010, and claims 1-80 of U.S. Patent No. 5,668,543.

However, Applicant submits that the present application claims priority to copending Application No. 08/852,119. Further, Application No. 08/852,119 claims priority to U.S. Patent No. 5,623,260, U.S. Patent No. 5,657,010, and U.S. Patent No. 5,668,543. Therefore, pursuant to 35 U.S.C. §154, any patent that will issue from the present application will have a term that will not exceed any of the terms of the foregoing patents, and as a result, there should be no unjustified term extension on a "right to exclude" that is already granted in any of the aforementioned patents. As such, the double patenting rejections to the pending claims of the present application are improper, and Applicant respectfully requests that the double patenting rejections be withdrawn.

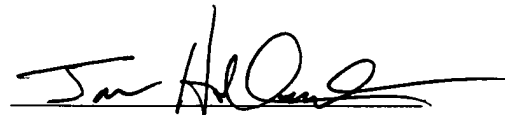
CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

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